

disclosure either anticipates or makes obvious the vehicle manufacturing method of claim 20. Specifically, that on the whole, Swidler's disclosure teaches toward the invention (rather than away) because he is mainly concerned with protecting new vehicle finishes, and discusses his method of transporting vehicles separately from generally protecting surfaces; and that it may be logically inferred from Swidler's disclosure (particularly the discussion under the Background of the Invention) that his coatings may be used during an assembly process, as well as during transportation.

Upon careful consideration applicant respectfully traverses such rejection, and submits that claim 20 is clearly patentably distinct over Swidler, for those reasons previously presented in Amendment-D, at pages 4-6, i.e., plainly, Swidler does not teach a vehicle manufacturing-assembly method, or any specific problems encountered during specific steps of same, whereas his complete disclosure "as a whole" actually teaches away from the claimed method in that he generally mentions damage to vehicle finishes during assembly, but specifically focuses on use of the coatings to prevent damage to vehicles (and other objects) during storage and shipping relative to special considerations relating thereto, and (again) never teaches use of his coatings in relation to a manufacturing process or any step thereof.

In this regard, applicant respectfully submits that the Examiner's asserted position is not supported by Swidler's actual disclosure for several reasons, including those previously discussed in Amendment-D and the following. Initially, the present claims do not define use of the strippable paint in general relation to a vehicle manufacturing method, but in relation to a specific assembly step (i.e., mounting an engine and functional parts to the vehicle "... while said strippable paint remains coated on the painted surface"). Swidler not only fails to

generally disclose use of a strippable paint in a vehicle manufacturing method, but certainly does not disclose, anticipate or suggest this specific step in any way. Further, although Swidler discloses and claims multiple methods, the broader of such methods (e.g., his claim 12) simply encompasses (as a main focus) more objects than vehicles, rather than encompassing an assembly process.

Based on the foregoing, applicant respectfully submits that the rejection of claim 20 based on the Swidler reference is overcome, and it is respectfully requested that such rejection be reconsidered and withdrawn.

The Examiner has rejected claims 20, 26, 27, 30-33, and 37-42 under 35 USC §103(a) as obvious over applicant's admitted prior art as described at pages 20-21 of the specification in view of Swidler '436 and the state of the art, as presented at item 4 of the Office Action. It is the Examiner's position that one skilled in the art would have found it obvious to use Swidler's strippable paint in place of an anti-scratch cover (such as applicant has disclosed is conventionally used in automobile manufacturing) during a vehicle assembly process, to realize the benefits thereof, that it would have been obvious to perform a step of finished product inspection (claim 26) following an assembly step, and that the subject matter of the other rejected claims "is held to be matters of engineering design choice."

Upon careful consideration applicant respectfully traverses such rejection, and again submits that each of the rejected claims is clearly patentably distinct over the applied art, for those reasons discussed above, for those additional reasons discussed at pages 6-7 of Amendment-D regarding the complete lack of evidence necessary to establish a factual basis in support the Examiner's holding regarding "[obvious] matters of engineering design choice",

and because the proposed hypothetical modification of the prior art assembly process (involving conventional use anti-scratch covers) at pages 20-21 of the application in view of a select teaching of Swidler ^{is} improperly based on a suggestion coming entirely from the Examiner (based on impermissible hindsight from applicant's disclosure), rather than from any teaching or suggestion which may be fairly gleaned from the actual prior art teachings as a whole.

Regarding the proposed hypothetical modification, again, applicant respectfully submits that Swidler does not disclose a vehicle assembly process or the use of his protective coating compositions during any step of an assembly process, but instead exclusively focuses on the use of his coating compositions for protecting new vehicle and other object finishes during storage and transportation. As such, persons of ordinary skill in the art would not consider it obvious to somehow modify the conventional vehicle assembly process by replacing use of conventional anti-scratch covers with use of protective films formed using Swidler's protective compositions, during the step of mounting of an engine and functional parts to the vehicle.

In this regard, applicant respectfully submits that the Examiner's interpretation of relevant portions of Swidler's disclosure is not supported by Swidler's actual, full, fair disclosure. For example, Swidler does not generally teach replacement of anti-scratch covers with his coating compositions, as the Examiner alleges. Rather, Swidler generally discusses that "Various solutions have been attempted to protect the exposed surfaces of vehicles during the manufacturing and transportation." However, in specifically discussing "Physical protection (e.g., covering the vehicle with plastic or canvas)", he also specifically discusses

that such physical protection "... is prohibitively expensive for *mass shipments or typical driving* (emphasis added)" , thus very plainly limiting his proposed use of his coatings subsequent to the manufacturing of vehicles. Swidler also specifically discusses that the types of physical covers he proposes to replace "... create solid waste problems as they are not readily reusable", which is again contrary to the anti-scratch covers used during the prior art vehicle assembly method mentioned in the present specification (see page 23, lines 1-5).

Based on the foregoing, applicant respectfully submits that the rejection of claims 20, 26, 27, 30-33, and 37-42 based on applicant's admitted prior art on pages 20-21 of the specification and the Swidler reference is overcome, and it is respectfully requested that such rejection be reconsidered and withdrawn.

The Examiner has also rejected claims 20, 26, 27, 30-33, and 37-42 under 35 USC §103(a) as being unpatentable over Swidler '436 in view of the state of the art, as presented at item 5 of the Office Action. It is unclear, however, whether this rejection was intended to be limited to claims 26, 27, 30-33, and 37-42 because the Examiner already rejects claim 20 under 35 USC §103(a) as being unpatentable over Swidler '436 at item 3, and because the Examiner does not discuss claim 20 in item 5.

Upon careful consideration applicant respectfully traverses such rejection is, again, for those reasons discussed above, and for those additional reasons discussed at pages 6-7 of Amendment-D regarding the lack of necessary evidence (factual basis) to support the Examiner's allegation regarding "obvious matters of engineering design choice". Again, it is respectfully requested that the rejection be reconsidered and withdrawn.

Examiner Inquiries

At item 6 of the Office Action, the Examiner asserts that the significance of the subject matter of several of applicant's claims (those which the Examiner rejects as obvious matters of engineering design choice) is not clear from applicant's disclosure, and that this lack of clarity justifies the Examiner's rejection. Further, the Examiner has posed several additional inquiries for response by the applicant relating to the specific strippable paint discussed in the application as usable in applicant's methods.

Upon careful consideration, applicant respectfully traverses the Examiner's assertion (again) because the significance of such claim limitations is expressly discussed in the application, including the discussion at pages 13-16 of the specification, and would be plainly understood by persons of ordinary skill in the art.

Further, concerning the Examiner's further additional inquiries at item 6 of the Office Action, regarding the "Lapguard" strippable paint product mentioned in the specification, applicant responds as follows.

1. Applicant has already answered very similar (overlapping) inquiries from the Examiner in the past, including the Supplemental Response dated December 20, 1999, wherein applicant stated that they are not aware of any prior art teaching of preliminary and non-preliminary drying means/steps.

2. Applicant has conducted a search for the specific composition of the "Lapguard" product, but has been unable to locate same. The product is, as discussed in the application, commercially available from a Japanese corporation named Kanasi Paint Ltd.

3. Rule 56(a) does not impose any duty on applicant to go out and perform research for the Examiner, but only to disclose subject matter which is known by the applicant. If the

Examiner continues to demand further responses from applicant, applicant will make an attempt to obtain the composition formula by directly contacting Kansai Paint Ltd.

Applicant notes that, at item 7 of the Office Action, the Examiner has withdrawn the rejections contained in the Examiner's Answer dated February 16, 1999.

The Examiner has rejected claims 20, 26, 27, 30-33, and 37-42 under 35 USC §103(a) as being unpatentable over applicant's admitted prior art at pages 20-21 of the specification in view of applicant's admitted prior art at page 2, lines 7-8 of the specification, as presented at item 8 of the Office Action. It is the Examiner's position that: it would have been obvious to one of ordinary skill in the art to substitute a strippable paint (as discussed by applicant as being conventionally applied to small parts) for an anti-scratch cover in a conventional vehicle assembly process as discussed at pages 20-21 of the specification, for the purpose of realizing the benefits that the strippable paint exhibits relative to the anti-scratch cover, and based on the Examiner's presumption that the coated small parts are assembled together after coating; and for the other alleged reasons of obviousness based on engineering design choice, etc.

Upon careful consideration applicant respectfully traverses such rejection, and submits that each of the claims are clearly patentably distinct over the applied art, because the hypothetical modification of the conventional vehicle manufacturing process by selectively replacing the anti-scratch covers used therein with a strippable paint that has been applied to protect small parts, as proposed by the Examiner, is improperly based on a suggestion coming entirely from the Examiner (as guided by impermissible hindsight of applicant's disclosure), rather than from any teaching or suggestion which may be fairly gleaned from the prior art itself; and for all the additional reasons discussed above regarding "obvious matters of

engineering design choice", etc.

Regarding the proposed modification, applicant respectfully submits that the generally known concept of coating small parts with a strippable paint (as discussed in the specification and in US Patent 5,542,699 cited by applicant on December 20, 1999 in relation to the Examiner's inquiries) is very much different and non-analogous to "mounting an engine and functional parts" to a vehicle in a vehicle manufacturing method given the much greater size and weight of the engine and functional parts on a vehicle, and the potential damage they may caused thereby in comparison to such small parts. As such, persons skilled in the art would never consider it obvious to hypothetically modify the conventional vehicle manufacturing process as proposed by the Examiner because there is no reason or motivation for doing so, absent impermissible hindsight gained from applicant's disclosure.

In this regard, the Examiner provides no factual basis to show/establish that concerns relating to small parts are the same as those relating to mounting of an engine and functional parts to a vehicle in a vehicle manufacturing process.

In view of the foregoing, it is respectfully submitted that the Examiner has failed to establish prima facie obviousness under 35 USC §103(a) of the rejected claims based on applicant's admitted prior art, and accordingly it is respectfully requested that the rejection be reconsidered and withdrawn.

Additionally, applicant notes the Examiner's repeated inquiry at the end of item 8 regarding assembly of small coated parts. Applicant respectfully submits that this inquiry is not understood by applicant in light of the Supplemental Response dated December 20, 1999, which addresses this inquiry, and in which US Patent 5,542,699 was provided for the

Examiner's consideration.

The Examiner has presented comments (a quasi-rejection of all claims) at item 9 of the Office Action involving the Langerbeins reference (US Patent 5,061,518). Particularly, it is the Examiner's position that the teaching at col. 1, lines 14-16 of Langerbeins is further evidence of the obviousness of using the known strippable compositions to protect vehicle finishes during the assembly thereof.

Upon careful consideration applicant respectfully traverses such comments/rejection for all of the reasons discussed previously, and because the Langerbeins reference does not disclose or suggest the general teaching which the Examiner asserts that it does. Particularly, the general statement of Langerbeins which the Examiner cites is, "The protection can be one against weathering; it can however also be protection against mechanical attack, e.g., in the further processing of manufactured articles." Significantly, however, in the very next sentence Langerbeins goes on to explain "The best known example is the preservation of auto bodies for transport and for their outdoor storage, for which coatings of waxes are usually applied." As understood from other known teachings in the art (e.g., the discussion at col. 1, lines 14-38 in the Swidler '436 patent), the mechanical attack discussed by Langerbeins is encountered during transport of the vehicle bodies from rail dust or the like. As such Langerbeins does not provide any additional basis to adequately support the Examiner's rejections under 35 USC §103(a).

In conclusion, applicant has overcome the Examiner's rejections of claims as presented in the Office Action; and moreover, applicant has considered all of the references of record, and it is respectfully submitted that the invention as defined by each of the present claims is

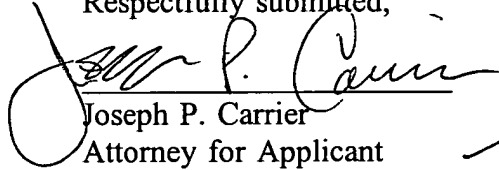
clearly patentably distinct thereover.

The application is now believed to be in condition for allowance, and a notice to this effect is earnestly solicited.

Favorable reconsideration is again respectfully requested.

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the US Postal Service as first class mail in an envelope addressed to the Box Non-Fee Amendments, Assistant Commissioner for Patents, Washington, DC 20231, on June 15, 2000.

JPC/ms

